

## **REMARKS**

Claims 1, 3-26 and 40-52 appear in this application for the Examiner's review and consideration. Applicant respectfully requests reconsideration of the claims in light of the following remarks.

### **1. Corrected Formal Drawings**

Applicant notes with appreciation that the proposed drawing corrections and/or the proposed substitute sheets of drawings filed on August 26, 2002 have been approved by the Examiner (see Office Action page 2). Submitted herewith, attached hereto as Exhibit A, are corrected formal drawings, i.e., Figures 1-3.

### **2. Rejection of Claims 1, 3, 5-10, 14, 16, 20, 22, 26, 44, 47-49 and 52 under 35 U.S.C. § 103(a)**

Claims 1, 3, 5-10, 14, 16, 20, 22, 26, 44, 47-49 and 52 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,345,726 to Beeuwsaert ("Beeuwsaert") in paragraph 3 of the Office Action. Applicant respectfully traverses.

The Office Action alleges that Beeuwsaert discloses a complexable layer, e.g., #9 and #10 in Figure 2 of Beeuwsaert. Applicant respectfully disagrees. As applicant has previously pointed out, the previous remarks from the Amendment filed on April 15, 2003 being expressly incorporated by reference herein, Beeuwsaert's layers 9-13 are unitary, i.e., they act as if they were only one layer. Thus, Beeuwsaert's layers 9-13 act as a tearable welding layer, which is admitted in the Office Action (see page 2, line 6 from the bottom). On one hand, the Office Action refers to unitary layers when referring to, e.g., adhesive layer 6 in Figure 1 of Beeuwsaert and tearable-welding layer 7 in Figure 1 of Beeuwsaert. On the other hand, the Office Action refers to a subset of layers, i.e., #9 and #10 in Figure 2 of Beeuwsaert, as a complexable layer. Applicant respectfully points out this inconsistency, i.e., layers 9-13 (inclusive) are considered to be a tearable welding layer while, at the same time, layers #9 and #10 thereof are considered to be a complexable layer. For at least this reason, applicant maintains that there is no disclosure in Beeuwsaert of the complexable layer recited in the present claims, which is separate from the recited tearable-welding layer.

The Office Action also alleges that it "would have been obvious ... to rearrange the layers such that the complexable layer is situated between the PSA and the support layers ... ." (See page 3 of the Office Action). As previously pointed out, there must be some motivation to make any rearrangement AND a reasonable expectation of success. The sole motivation to make a rearrangement AND the reasonable expectation of success thereof offered by the Office Action is that "rearranging parts of an invention involves only routine skill in the art". First, the understanding of "complexable layer" as Beeuwsaert's layers #9 and #10 is not correct for all of the reasons discussed above. Second, since each of Beeuwsaert's layers, e.g., 3, 6 and 7, has a defined function and each is placed in the order or position disclosed in Beeuwsaert because of that function, there is no motivation provided by the Beeuwsaert reference to "rearrange" Beeuwsaert's layers within that function. "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims ... is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984). See also MPEP § 2144.04(VI.) (C); *cf. In re Japikse*, 86 USPQ 70, 73 (CCPA 1950) ("[T]here would be no invention in shifting the starting switch ... to a different position since the operation of the device would not thereby be modified.") (emphasis added).

In particular, Beeuwsaert's adhesive layer 6 is situated between the support layer and the welding layer. Layer 6 is disclosed to be deposited onto the supporting layer 5 (see col. 4, lines 3-5) or between the support layer 5 and the weldable layer 7 (see col. 4, lines 12-15). Given the operative conditions, the PSA must necessarily be freed after tearing the package, meaning that the PSA must be beneath the weldable layer. The weldable layer is referenced as 7 in Beeuwsaert (see Figures 1-3 therein) and is disclosed "to be preferably composed of 5 layers" (see col. 2, line 51; col. 4, lines 45-47). However, this cannot be interpreted to mean that each sublayer can be placed at different locations in the multilayer structure of the packaging. Rather, the term "composed of" indicates that it is not possible to dissociate the sub-layers. In fact, the entire process and operative conditions are always given with respect to the "macroscopic" layers, i.e., those referenced as 5, 6, 7 and 3 by Beeuwsaert. There is no disclosure of the role of each sub-layer within any macroscopic layer. Again, this demonstrates that the sublayers in Beeuwsaert cannot be used independently one from another.

Also, as has previously been pointed out, given that Beeuwsaert is related to gas-tight packages, it is likely that the 5 layer structure is of the following type:

PE/Tie/EVOH/Tie/PE

were tie is synonymous with binder. With this type of "subassembly" for macroscopic layer 7, it is not possible to have one or more sublayer(s) considered independently one from the other.

"Rearrangement of the layers" also cannot be understood to mean that the PSA layer be placed within another macroscopic layer. Regardless of its location within the structure, the PSA layer must still provide its effect, i.e., adherability, when it is freed upon tearing the package. Gas-tightness is obtained by Beeuwsaert from the peripheral seal, where the inner volume would be between two gas-barrier layers (the EVOH layers) and seals at the periphery. Gas-tightness, in this case, does not allow for a rearrangement of the layers.

Only for the sake of argument, even with the rearrangement proposed by the Office Action (which is contested, as discussed above), the following layered structure would be obtained:

Support/PE/Tie/PSA/EVOH/Tie/PE // cover

Such a layered structure is not recited by the rejected claims because it would not provide the re-closable package recited therein.

Accordingly, applicant submits that the rejection of the claims as unpatentable over Beeuwsaert has been overcome and respectfully requests that this rejection be reconsidered and withdrawn.

**3. Rejection of Claims 2, 4, 11, 12, 17-19, 21, 23-25 and 51 under 35 U.S.C. § 103(a)**

Claims 2, 4, 11, 12, 17-19, 21, 23-25 and 51 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Beeuwsaert in view of, *inter alia*, U.S. Patent No. 3,454,210 to Spiegel et al. ("Spiegel") in paragraph 4 of the Office Action. Applicant respectfully traverses.

The Office Action alleges that it "would have been obvious ... to have modified Beeuwsaert to include a multilayered welding structure as taught by Spiegel in order to

provide a package that is easily opened while having a positive reclosable feature as well as to increase the free surface energy of the PE layers ... ." (See page 7 of the Office Action). As there is no disclosure of increasing the surface energy of the PE layers in Beeuwsaert; there is no motivation to revert to the disclosure of Spiegel to provide that aspect. Moreover, as applicant has previously pointed out, the previous remarks from the Amendment filed on April 15, 2003 being expressly incorporated by reference herein, the embodiments disclosed in Spiegel are directed towards packages with the adhesive in the lid, not in the container. It should be noted that although claim 13 of Spiegel mentions adhesive in the base member, there is no disclosure in Spiegel on how to make such structure; therefore, as Spiegel lacks enabling disclosure for at least this aspect, Spiegel cannot qualify as a prior art document for at least this aspect. Thus, there can be no motivation to apply Spiegel's "lid teaching" to the container part of the package, as recited in the presently rejected claims.

With regard to the other references cited in this rejection and their proposed combination, rather than repeat the previous remarks from the Amendment filed on April 15, 2003, applicant expressly incorporates the same by reference herein.

Even if, only for the sake of argument, the references are combined as suggested in the present Office Action, applicant submits that the combination of Beeuwsaert; Spiegel; the Material Safety Data Sheet for PENTALYN H-55WBX; the Material Safety Data Sheet for PETROFLEX SBR, the *Encyclopedia of Polymer Science and Technology* internet entry for *Ethylene Polymers, LLDPE*; WO 97/19867 to Engelaere; and U.S. Patent No. 4,791,024 to Clerici et al. fails to teach or suggest all of the limitations of the claims. Additionally, the Office Action points to no suggestion or motivation existing within the collective references to make the combination and the modification asserted in the Office Action. Furthermore, even if the references were to be combined as suggested in the Office Action, the presently claimed invention could be, at most, merely obvious to try, which is insufficient to establish *prima facie* case of obviousness because a reasonable expectation of success would be lacking.

Therefore, as there can be no *prima facie* obviousness, applicant submits that the rejection of the claims over the cited combination has been overcome and respectfully requests that the rejection be withdrawn.

**4. Rejection of Claim 13 under 35 U.S.C. § 103(a)**

Claim 13 is rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Beeuwsaert in view of U.S. Patent No. 5,167,339 to Takata et al. in paragraph 5 of the Office Action. The invention recited in the rejected claim is not rendered obvious by the proposed combination because, *inter alia*, these references do not even suggest the structures recited in the claims. Applicant respectfully traverses, expressly incorporates by reference herein the previous remarks from the Amendment filed on April 15, 2003 relating to this rejection, submits that the rejection of claim 13 over the cited combination has been overcome, and respectfully requests that the rejection be withdrawn.

**5. Rejection of Claim 15 under 35 U.S.C. § 103(a)**

Claim 15 is rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Beeuwsaert in view of U.S. Patent No. 5,882,749 to Jones et al. in paragraph 6 of the Office Action. The invention recited in the rejected claim is not rendered obvious by the proposed combination because, *inter alia*, these references do not even suggest the structures recited in the claims. Applicant respectfully traverses, expressly incorporates by reference herein the previous remarks from the Amendment filed on April 15, 2003 relating to this rejection, submits that the rejection of claim 15 over the cited combination has been overcome, and respectfully requests that the rejection be withdrawn.

**6. Rejection of Claims 40-43, 45, 46 and 50 under 35 U.S.C. § 103(a)**

Claims 40-43, 45, 46 and 50 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Beeuwsaert in view of U.S. Patent No. 6,106,153 to Toshima ("Toshima") in paragraph 7 of the Office Action. Applicant respectfully traverses.

As Toshima can be considered to be a disclosure of packaging with adhesive in the lid, Toshima is not relevant to the present claims. In particular, e.g., see Figures 4a, 4b and 5 of Toshima, Toshima discloses that the adhesive 14 is part of the fusing tape 6 portion, i.e., the lid, that is fused with the bag of the package (see col. 4, lines 58-62; col. 5, lines 19-20), and not the surface 2 of the bag. In contrast, the present claims recite that the adhesive is in the container, which might be analogized not to Toshima's tape but to Toshima's bag.

Even if, only for the sake of argument, the references are combined as suggested in the present Office Action, applicant submits that the combination of Beeuwsaert and Toshima

fails to teach or suggest all of the limitations of the claims. Additionally, the Office Action points to no suggestion or motivation existing within the collective references to make the combination and the modification asserted in the Office Action. Furthermore, even if the references were to be combined as suggested in the Office Action, the presently claimed invention could be, at most, merely obvious to try, which is insufficient to establish *prima facie* case of obviousness because a reasonable expectation of success would be lacking.

Therefore, as there can be no *prima facie* obviousness, applicant submits that the rejection of the claims over the cited combination has been overcome and respectfully requests that the rejection be withdrawn.

## 7. Conclusion

Favorable consideration of the application in view of the remarks herein is respectfully requested. It is believed that the present claims are in condition for allowance, early notice of which would be appreciated.

No fees, other than that for extending the period for response, are believed due for this submission. However, should any additional fee(s) be required, the Patent and Trademark Office is authorized to charge the requisite amount to Jones Day Deposit Account No. 16-1150.

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Respectfully submitted,

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Enclosures

**EXHIBIT A**

**CORRECTED DRAWINGS**

**U.S. PATENT APPLICATION SERIAL NO. 09/574,836**